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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323

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WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,098

Applicant(s)

BERNSTEIN, ROBERT

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-912)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

SPECIFICATION OBJECTION—Typographical Error

2. In the specification at least at p. 7, line 15, after the word “materials”, delete the word “fore” and replace it with the word –for–. Please check the whole specifications for typographical errors. Appropriate corrections are required.

CLAIM REJECTIONS — 35 U.S.C. §101

3. Rejections Maintained for Claims 1-16.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those portions of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections is set forth in a prior Office action:

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4. Claims 1-22 are rejected under 35 U.S.C. §103(a) as being obvious over Katz US 6,055,513 (Apr. 25, 2000) [US f/d: Mar. 11, 1998] (herein referred to as "Katz").

As per claim 1, Katz at least at (the ABSTRACT; FIG. 4; col. 1, ll. 5-17; col. 8, ll. 53-60; col. 10, ll. 1-25; col. 10, ll. 33-67; col. 12, ll. 1-25; col. 15, ll. 55-67; col. 18, ll. 1-15; col. 18, ll. 40-67; col. 19, ll. 1-67; col. 23, ll. 5-40; col. 24, ll. 1-67; and col. 25, ll. 25-55) shows: "A method of identifying potential customers for delivery of promotional materials. . . ."

Katz at least at (FIG. 2; col. 5, ll. 40-67; and col. 9, ll. 5-67) shows: "accumulating data about customers . . . where such accumulated data is saved within a database of a third party. . . ."

Katz at least at (FIG. 6; col. 4, ll. 3-67; and col. 7, ll. 35-45) shows: "forming a customer profile by a vendor . . . for targeting delivery of the promotional materials to potential customers. . . ."

Katz at least at (FIG. 2; the ABSTRACT; col. 8, ll. 63-67; and col. 9, ll. 40-65) shows: "searching the database and identifying customers which match the customer profile within the database of the third party. . . ."

Katz at least at (FIG. 4, el. 148; col. 8, ll. 32-45; col. 8, ll. 60-63; col. 11, ll. 53-55; col. 21, ll. 5-67; and col. 22, ll. 1-67) shows: "forwarding promotional materials to the identified customers."

Katz lacks an explicit recitation of: "a plurality of independent vendors. . . ."

Official Notice is taken that both the concepts and the advantages of "a plurality of independent vendors. . . ." were notoriously well known and expected

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in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . . .*” (see Katz (col. 8, ll. 33-40)).

As per claim 2, Katz shows the method of claim 1.

Katz (FIG. 6) shows: “detecting a purchase by a customer of the identified customers.”

Katz lacks an explicit recitation of the element in claim 1 from which claim 2 depends (i.e., “a plurality of independent vendors. . . .”).

Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means

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“for the intelligent selection and proffer of products, services or information to a user or customer. . . .” (see Katz (col. 8, ll. 33-40)).

As per claim 3, Katz shows the method of claim 2.

Katz (col. 3, ll. 15-67) shows: “wherein the step of forwarding promotional materials further comprises printing out the promotional materials at a point of sale of the purchase.”

Katz lacks an explicit recitation of the element in claim 1 from which claim 2, and subsequently claim 3 depends (i.e., “a plurality of independent vendors. . .”).

Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . . .*” (see Katz (col. 8, ll. 33-40)).

As per claim 4, Katz shows the method of claim 3.

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Katz (FIG. 9; col. 5, ll. 15-40; col. 6, ll. 1-10; col. 4, ll. 30-67; and col. 16, ll. 1-5) shows: “wherein the step of forwarding promotional materials further comprises printing out a coupon.”

Katz lacks an explicit recitation of the element in claim 1 from which claim 2, subsequently claim 3, and subsequently claim 4 depends (i.e., “a plurality of independent vendors. . .”).

Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . .*” (see Katz (col. 8, ll. 33-40)).

As per claim 5, Katz shows the method of claim 1.

Katz (col. 1, ll. 52-67; col. 3, ll. 1-15; col. 9, ll. 20-40; and col. 11, ll. 37-45) shows: “wherein the step of forwarding promotional materials further comprises composing an e-mail to the identified customer.”

Katz lacks an explicit recitation of the element in claim 1 from which claim 5 depends (i.e., “a plurality of independent vendors. . .”).

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Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . . .*” (see Katz (col. 8, ll. 33-40)).

As per claim 6, Katz shows the method of claim 5.

Katz (col. 14, ll. 28-56; and col. 22, ll. 13-31) shows: “wherein the step of forwarding promotional materials further comprises providing indicia of authenticity within the promotional materials.”

Katz lacks an explicit recitation of the element in claim 1 from which claim 6 subsequently depends (i.e., “a plurality of independent vendors. . . .”).

Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting*

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remote commerce . . . in electronic commerce. . . .” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . . .*” (see Katz (col. 8, ll. 33-40)).

As per claim 7, Katz shows the method of claim 1.

Katz (col. 2, ll. 55-67; col. 5, ll. 40-61; col. 8, ll. 5-22; col. 9, ll. 20-67; col. 10, ll. 1-25; col. 17, ll. 35-67; col. 18, ll. 1-15; and col. 21, ll. 32-55) shows: “the method of identifying potential customers as in claim 1 wherein the step of forming the customer profile further comprises specifying a geographical locale of prior purchases made b the potential customers.”

Katz lacks an explicit recitation of the element in claim 1 from which claim 7 depends (i.e., “a plurality of independent vendors. . . .”).

Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . . .*” (see Katz (col. 8, ll. 33-40)).

As per claim 8, Katz shows the method of claim 1.

Katz (col. 2, ll. 55-67; col. 5, ll. 40-61; col. 8, ll. 5-22; col. 9, ll. 20-67; col. 10, ll. 1-25; col. 17, ll. 35-67; col. 18, ll. 1-15; col. 21, ll. 32-55; and col. 24, ll. 12-60) shows: “the method of identifying potential customers as in claim 1 wherein the step of forming the customer profile further comprises specifying a subject matter of prior purchases made by the potential customers.” Katz lacks an explicit recitation of the element in claim 1 from which claim 8 depends (i.e., “a plurality of independent vendors. . .”).

Official Notice is taken that both the concepts and the advantages of “a plurality of independent vendors. . .” were notoriously well known and expected in the art at the time of the invention; and it would have been obvious to modify and interpret the disclosure of Katz cited above as implicitly showing: “a plurality of independent vendors. . .” because modification and interpretation of the cited disclosure of Katz cited above would have “*provided for effecting remote commerce . . . in electronic commerce. . .*” (see Katz (col. 8, ll. 33-40)); and based on the motivation to modify and interpret Katz so as to provide means “*for the intelligent selection and proffer of products, services or information to a user or customer. . .*” (see Katz (col. 8, ll. 33-40)).

Independent claim 9 is rejected for substantially the same reasons as independent claim 1.

Dependent claims 10-16 are rejected for substantially the same reasons as dependent claims 2-8 respectively.

Independent claim 17 is rejected for substantially the same reasons as independent claim 1.

Dependent claims 18-19 are rejected for substantially the same reasons as dependent claims 2-3 respectively.

Dependent claims 20-22 are rejected for substantially the same reasons as dependent claims 6-8 respectively.

RESPONSE TO ARGUMENTS

5. Applicant's arguments (Amendment paper filed 10/08/2004) have been considered but are not persuasive for the following reasons:

As per claims 1-8, as drafted, with the inclusion of a database per se in claim 1, where data are merely stored to be read or outputted without any functional interrelationship, does not impart functionality and is deemed non-functional descriptive material ; therefore said claims are still not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) albeit limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir.

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1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999); and said claims suffer from undue-breadth. It is well settled in the law that “Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention. . . . a rejection under 35 U.S.C. 112, second paragraph would be appropriate. . . . If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.” (See MPEP 2173.04 Breadth Is Not Indefiniteness (August 2001) p. 2100-195).

Furthermore, it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

As per claims 9-16, as drafted in independent claim 9, and reciting “means-plus-function” language for “identifying customers” and “forwarding promotional materials. . . .”, upon initial examination of the specification, p. 2, ll. 25-29; p. 4, ll. 12-19, the specification merely shows “using a data entry device 17 (e.g., a keyboard and display). . . .” The specification does not conclusively state that the “data entry device” consists of a “keyboard and display”; the specification merely provides as an example of

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an item where the Examiner has a broad range of possible interpretation of data entry devices.

In reference to the “means for forwarding promotional materials or messages to the identified customers. . . .” means-plus-function limitation of claim 9, the specification at p. 5, ll. 27-32, states that a mere example of distributing promotional materials is via “e-mail”; the specification does not conclusively state that the promotional means consists of distribution by “e-mail”; furthermore, the specification at p. 7, ll. 14-17 provides another example where the Examiner has a broad range of possible interpretation of distribution of promotional materials to identified customers.

Applicant’s arguments concerning the merits of the obviousness rejections are moot based on new grounds of rejection introduced by the Examiner in the instant Office action.

CONCLUSION

6. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

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(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V

2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

December 25, 2004